

REMARKS

The Official Action of July 6, 2004, and the references cited therein have been carefully considered. The Applicant respectfully requests reconsideration of the application in view of the following remarks. Claims 1-10 have been canceled without prejudice and rewritten for presentation as new Claims 11-18. Support for this amendment is found in the specification, e.g. at page 6, line 26 to page 8, line 24, and the claims of the application as filed.

Claims 11-18 are pending in the application.

1. Restriction Requirement

Under 35 U.S.C. §121, the Examiner required restriction among:

- I. Claims 1-7, drawn to compounds and compositions;
- II. Claims 8-10, drawn to methods of use.

In response to this requirement, the Applicants hereby affirm their election of Group I (Claims 1-7, compounds and compositions), with traverse.

Applicants respectfully request reconsideration and withdrawal of the foregoing requirement for restriction under 37 C.F.R. §1.143.

As stated in MPEP §803 there are two criteria for a proper requirement for restriction between patentably distinct inventions: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required.

As the Examiner noted, Groups I-II are patentably distinct as claimed. Applicants respectfully assert, however, that there will not be a serious burden on the Examiner if restriction is not required. The compounds of Groups I are employed in the methods of Groups II and provide a link between the groups, thus facilitating examination.

Because no serious burden for examination is present if restriction is not required, Applicants respectfully request withdrawal of the requirement for restriction.

Applicants further request that, consistent with Office practice for rejoinder of method claims, the non-elected Group II methods be rejoined upon allowance of Group I.

This election is being taken without prejudice to the filing of a divisional application directed to the non-elected subject matter. In accordance with the third sentence of 35 U.S.C. § 121, a patent issuing from the instant application should not be a reference against a divisional application filed before the issuance of such patent.

II. Rejection of Claims 1-7 under 35 U.S.C. § 103(a) over Merderski

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being obvious over Merderski.

The Applicant respectfully traverses this rejection and provide the following comments.

The Applicant respectfully asserts that the cited reference does not disclose or suggest the claimed invention. Nor would the cited reference have motivated or enabled one skilled in the art to employ the subject compounds in accordance with the claimed invention. Moreover, in view of the state of the art, one skilled in the art would have been discouraged from the compounds of the claimed invention.

As the Examiner acknowledges, Merderski discloses certain blood coagulation factor Xa inhibitors, which are useful for treating thrombo-embolic diseases. In contrast, the present compounds are ligands for GABA-A receptors and are therefor useful in the treatment of e.g., anxiety, convulsions or cognitive disorders.

The Applicants note that coagulation factor Xa inhibitors and ligands for GABA-A receptors act on entirely separate and unrelated pathways. Applicants respectfully submit that here would have been no reason that one skilled in the art would have considered the structure of the coagulation factor Xa inhibitors disclosed by Merderski when developing ligands for GABA-A receptors. The cited reference does not provide any motivation for modifying a coagulation factor Xa inhibitors to obtain a ligand for GABA-A receptors.


Similarly, there would have been no motivation for one of ordinary skill in the art to have selected specific compounds No. 52, 54 or 59 from over 65 compounds of Merderski and then to have made several structural changes (e.g. deleting CH₂ link at position 1, removing the substituent at position 2, etc.) to prepare the instant compounds which have activity as modulators of the GABA-A receptor. Moreover, the claims as presently amended do not include oxadiazole compounds (e.g. as the substituent Z) within their generic scope.

Accordingly, the Applicants respectfully assert that the rejection of Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as being obvious over Merderski is untenable and should be withdrawn.

Applicants respectfully contend that the application is allowable and a favorable response from the Examiner is earnestly solicited.

Respectfully submitted,

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